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Attorney Docket No. P31817C3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Giardina et al.

July 19, 2004

Serial No.: 10/721,644

Group Art Unit No.: 1625

Filed: November 25, 2003

Examiner: Zinna Northington Davis

For: QUINOLINE-4-CARBOXAMIDE DERIVATIVES AS NK-2 and NK-3
RECEPTOR ANTAGONISTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO REQUIREMENT FOR RESTRICTION
UNDER 35 U.S.C. §121

Sir:

This paper is in response to the Official Action dated June 17, 2004, setting forth a thirty (30) day shortened statutory period for reply. This Response is being filed within said period, and no fees are believed due. However, authorization is hereby given to deduct any fees required by this paper to Deposit Account No. 19-2570, should any fees be due.

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ELECTION/RESTRICTION

A requirement for restriction and election has been made under 35 U.S.C. § 121 (37 C.F.R. § 1.142) among the alleged distinct inventions of the following groups:

Group I. Claims 1-11, 13 and 14, drawn to a compound, composition and process of preparing a compound of formula I;

Group II. Claims 16 and 18, drawn to a compound of formula I and method of treatment and/or prophylaxis of the Primary and Secondary Conditions in a mammal; and

Group III. Claim 19, drawn to a compound of formula I for the use as a diagnostic tool for assessing the degree to which neurokinin-3 and neurokinin-2 receptor activity is implicated in the patient's symptoms.

Applicant is requested to elect a single disclosed species for prosecution on the merits. Applicant respectfully traverses the requirements for restriction and election and requests reconsideration.

It is urged that the above Groups are merely different embodiments of a single inventive concept for which a single patent should issue and do not constitute distinct inventions such as to require that the subject matter be prosecuted in separate patent applications. In particular, the instant invention relates to novel compounds, all of which are claimed to have the same utility, i.e., as neurokinin antagonists. Furthermore, since the compounds have a core nucleus of structure there is not an undue burden on the Examiner with respect to searching the subject matter of the invention.

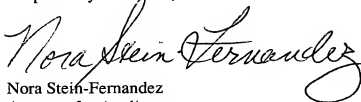
The Examiner's attention is invited to M.P.E.P. § 808 which states that the reasons for insisting upon restriction or election must be given. No adequate reason is offered in the Official Action for the requirements for restriction and election. Absent such reasoning, the requirements for restriction and election should be withdrawn.

However, pursuant to 37 C.F.R. §§ 1.142 and 1.143, Applicant provisionally elects, subject to the traverse set forth above, Group I, covering claims 1-11, 13 and 14, drawn to a compound, composition and process of preparing a compound of formula I and the compound species of Example 1, i.e., (S)-N-(α -Ethylbenzyl)-3-[(S)-2-(methoxycarbonyl)pyrrolidin-1-yl]-2-phenylquinoline-4-carboxamide hydrochloride. In the event the requirements are made final, Applicants hereby reserve the right to file one or more divisional applications directed to the non-elected subject matter.

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In view of the foregoing, favorable reconsideration of claims 1-11, 13, 14, 16, 18 and 19, withdrawal of the requirements for restriction and election, and allowance of this application are earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Nora Stein-Fernandez". The signature is fluid and cursive, with the first name "Nora" and last name "Fernandez" clearly legible, and "Stein" written in a smaller, more compact script between them.

Nora Stein-Fernandez
Attorney for Applicants
Reg. No. 36,689

GLAXOSMITHKLINE
Corporate Intellectual Property - UW2220
P.O. Box 1539
King of Prussia, PA 19406-0939
Phone (610) 270-5044
Facsimile (610) 270-5090